

REMARKS

Claims 9-24 are pending in the application. Claims 9-24 are rejected under 35 U.S.C. §112, first paragraph. Further, claims 9-24 are rejected under 35 U.S.C. §101. Additionally, claims 9-24 are rejected under 35 U.S.C. §103(a). Applicants address these rejections below.

I. REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH:

The Examiner has rejected claims 9-24 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Office Action (5/29/2009), page 4. In particular, the Examiner asserts that the particular phrase of "a computer readable medium" in claims 9 and 13 is not found in the Specification. *Id.* Additionally, the Examiner asserts that the aspect of a "processor" as recited in claims 17 and 21 was not mentioned in the Specification.

The enablement requirement refers to the requirement of 35 U.S.C. §112, first paragraph, that the specification describe how to make and how to use the invention. M.P.E.P. §2164. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent. *Id.*

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. M.P.E.P. §2164.01. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? *Id.*

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. A patent need not teach, and preferably omits, what is well known in the art. M.P.E.P. §2164.01.

The Examiner must provide objective evidence rather than relying on his own subjective opinion as to the assertion that "undue experimentation" would have been needed to make and use the claimed invention. The Examiner must consider factors in determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." M.P.E.P. §2164.01(a). These factors include, but are not limited to: (a) the breadth of the claims; (b) the nature of the invention; (c) the state of the prior art; (d) the level of one of ordinary skill; (e) the level of predictability in the art; (f) the amount of direction provided by the inventor; (g) the existence of working examples; and (h) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *Id.*

The Examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. M.P.E.P. §2164.01(a). A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *Id.* The Examiner has not considered any evidence related to any of the factors discussed above. The Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention which is satisfied by considering the factors related above. *Id.* Since the Examiner has not considered any evidence related to any of the factors discussed above, the Examiner has not met his initial burden of proving that claims 9, 13, 17 and 21 fail to comply with the enablement requirement. Consequently, claims 9-24 are allowable under 35 U.S.C. §112, first paragraph.

Furthermore, the Examiner is focused on the preamble of claims 9 and 13 which recite a computer readable medium. While the particular phrase "a computer readable medium" may not be found in the Specification, there is language directed to a computer program product (see, e.g., paragraph [0005] of Applicants' Specification) which necessarily implies the teaching of a computer readable medium. As a result, undue or unreasonable experimentation is not required to practice the invention

claimed in claims 9 and 13. Accordingly, the specification complies with the enablement requirement in connection with claims 9 and 13. Consequently, claims 9-16 are allowable under 35 U.S.C. §112, first paragraph.

Additionally, in connection with the aspect of a processor not being mentioned in the Specification, there is language directed to a computer program product (see, e.g., paragraph [0005] of Applicants' Specification) which necessarily implies the teaching of a computer. All computers have a processor, and as a result, undue or unreasonable experimentation is not required to practice the invention claimed in claims 17 and 21. Accordingly, the specification complies with the enablement requirement in connection with claims 17 and 21. Consequently, claims 17-24 are allowable under 35 U.S.C. §112, first paragraph.

## II. REJECTIONS UNDER 35 U.S.C. §101:

The Examiner has rejected claims 9-24 under 35 U.S.C. §101 because the claimed inventions are allegedly directed to non-statutory subject matter. Office Action (5/29/2009), page 5. In particular, the Examiner cites to *Gottschalk v. Benson* and M.P.E.P. §2106.02 in support of the assertion that the limitations of claims 9, 13, 17 and 21 are "acts of a claimed process" that "manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter." *Id.*

Applicants kindly point out to the Examiner that claims define a non-statutory process if they consist solely of mathematical operations without some claimed practical application or if they simply manipulate abstract ideas without some claimed practical application. M.P.E.P. §2106.02. Claims 9, 13, 17 and 21 clearly include a claimed practical application. Claims 9 and 13 are a computer program product and claims 17 and 21 are a process with claims directed to a practical application as defined in M.P.E.P. §2106(IV)(C)(2). According to M.P.E.P. §2106(IV)(C)(2), a claimed invention is directed to a practical application of a 35 U.S.C. §101 judicial exception when it: (A) transforms an article or physical object to a different state or thing; or (B) otherwise produces a useful, concrete and tangible result.

The final result achieved by claims 9, 13, 17 and 21 (determining an overall score for the software product requirement from the partial scores) is a useful, tangible and concrete result as defined in M.P.E.P. §2106(IV)(C)(2) and in *State Street Bank v. Signature Financial*, 47 U.S.P.Q.2d 1596, 1601 (Fed. Cir.1998) (transformation of data representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm...because it produces a useful, concrete and tangible result). Further, claims 9 and 13 are directed to a computer program product which involves a transformation.

Additionally, the Examiner has rejected claims 17-24 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. Office Action (5/29/2009), page 5. In particular, the Examiner states, citing *In re Bilski*, that the process claims (claims 17 and 21) must (1) be tied to a particular machine or apparatus or (2) transform the underlying subject matter (such as an article or material) into a different state or thing. *Id.* As indicated above, Applicants amended claims 17 and 21 to indicate the aspect of a processor performing the step of determining an overall score for the software product requirement. Therefore, process claims 17-24 satisfy the test laid out in *In re Bilski* and are directed to statutory subject matter.

As a result of the above, Applicants kindly request the Examiner to withdraw the rejections of claims 9-24 under 35 U.S.C. §101.

### III. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 9-12 and 17-20 under 35 U.S.C. §103(a) as being unpatentable over Kinra et al. (U.S. Patent No. 5,731,991) (hereinafter "Kinra"). Further, the Examiner has rejected claims 13-16 and 21-24 under 35 U.S.C. §103(a) as being unpatentable over Kinra in view of Wolfram MathWorld (hereinafter "Wolfram"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

- A. Claims 9-12 and 17-20 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Kinra.

Applicants respectfully assert that Kinra does not teach "computing partial scores for the customer interest categories by weighting and summing the numerical values" as recited in claim 9 and similarly in claim 17. The Examiner cites elements 114a-114c and 126a-126d of Kinra as teaching the claimed customer interest categories and further cites elements 112 and 124 of Kinra as teaching the claimed supplier metrics. Office Action (12/10/2008), page 4; Office Action (5/29/2009), page 8. Additionally, the Examiner cites elements 118 and 130 as teaching the claimed numerical values. *Id.* Further, the Examiner cites column 4, lines 33-68 of Kinra as teaching the above-cited claim limitation. *Id.* Applicants respectfully traverse.

Kinra teaches that criterion evaluation table 122 corresponds to the prototyping and simulation criterion 114c in category evaluation table 111. Column 8, lines 39-41. Kinra further teaches that a product data column 124 of criterion evaluation table 122 includes a list of product data within the prototyping and simulation criterion, where this product data comprises a plurality of evaluation statements 126a-126d. Column 8, lines 41-44. Further, Kinra teaches that a weighting column 128 of criterion evaluation table 122 contains the criterion weighting values 24 for each product data specified in product data column 124. Column 8, lines 44-47. Additionally, Kinra teaches that a PRODUCT 1 value column 130 and a PRODUCT 2 value column 132 contain the numerical values for PRODUCT 1 and PRODUCT 2, respectively, corresponding to the evaluation statements listed in product data column 124. Column 8, lines 47-51. Additionally, Kinra teaches that a normalized criterion score in the prototyping and simulation criterion is provided at the end of each of the PRODUCT 1 and PRODUCT 2 value columns. Column 8, lines 51-54.

Hence, Kinra teaches generating normalized criterion scores for the prototyping and simulation criterion (Examiner asserts that the prototyping and simulation criterion 124 corresponds to the claimed supplier metrics) for products 1 and 2 as illustrated in table 122 of Figure 2. Similarly, Kinra teaches generating normalized criterion scores for the prototyping and simulation criterion for products 1 and 2 as illustrated in table 122 of Figure 2.

Kinra further teaches the process in generating normalized scores, which involves dividing the raw criterion score by the sum of the associated criterion weighting values. Column 4, lines 33-67.

There is no language in Kinra that teaches computing partial scores for the customer interest categories by weighting and summing the numerical values. Instead, Kinra teaches computing normalized scores for the prototyping and simulation criterion which the Examiner asserts teaches the claimed supplier metrics and not the claimed customer interest categories. There is no weighting and summing being performed to obtain the scores associated with elements 126a-126d which the Examiner alleges teaches the claimed customer interest categories.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Claims 10-12 and 18-20 each recite combinations of features of independent claims 9 and 17, respectively, and hence claims 10-12 and 18-20 are patentable over Kinra for at least the above-stated reasons that claims 9 and 17, respectively, are patentable over Kinra.

Claims 10-12 and 18-20 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Kinra.

For example, Kinra does not teach "wherein the customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability" as recited in claim 10 and similarly in claim 18. The Examiner cites column 4, lines 1-4 and element 112 of Figure 2 of Kinra as teaching the aspects of usability, interoperability and capability. Office Action (12/10/2008), pages 4-5; Office Action (5/29/2009), page 9. Applicants respectfully traverse.

Kinra teaches that exemplary criteria include ease of use, application interoperability, automated testing, application partitioning, process modeling, prototyping and simulation, and multilingual support. Column 4, lines 1-4.

The Examiner had previously asserted that elements 112 and 124 correspond to the claimed supplier metrics. Office Action (12/10/2008), page 4. The exemplary criteria cited by the Examiner in column 4, lines 1-4 of Kinra refer to element 124. Hence, using the Examiner's interpretation of "supplier metrics," the Examiner has not shown that Kinra teaches that customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 10 and 18, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Further, the Examiner asserts that the categories of performance, reliability, maintainability, documentation, and serviceability are old and well known. Office Action (12/10/2008), page 5. While these categories may be known, Applicants respectfully traverse the implied assertion that having the customer interest categories selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, where supplier metrics are evaluated for these customer interest categories is well known in the art. Applicants kindly request the Examiner to provide a reference that teaches having the customer interest categories selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, where supplier metrics are evaluated for these customer interest categories pursuant to M.P.E.P. §2144.03.

Additionally, the Examiner asserts that the categories of performance, reliability, maintainability, documentation, and serviceability are nonfunctional material and therefore can be ignored in light of *In re Gulack* and *In re Lowry*. Office Action (5/29/2009), page 9. Applicants respectfully traverse.

The cases that the Examiner cites are found in M.P.E.P. §2106.01. According to M.P.E.P. §2106.01, *In re Gulack* and *In re Lowry* are directed to the situation in which the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine. M.P.E.P. §2106.01. That

is not the case here. As pointed out, there are numerous limitations in the claimed inventions not taught or suggested in Kinra. Consequently, the Examiner's reliance of *In re Gulack* and *In re Lowry* is improper.

Further, M.P.E.P. §2106.01 defines "non-functional descriptive material" as including but not limited to music, literary works, and a compilation or mere arrangement of data. M.P.E.P. §2106.01 continues by stating that when non-functional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. M.P.E.P. §2106.01 further states that merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, does not make it statutory. Further, M.P.E.P. §2106.01 states that non-statutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

The above-recited limitation that the Examiner claims to be non-functional descriptive material is not related to music, literary works, a compilation or mere arrangement of data. Neither is this claim limitation an abstract idea. Neither is this claim limitation protectable under copyright law. This limitation is not non-functional descriptive material.

The above-cited claim limitation is directed to further defining the customer interest categories. These are defined to be selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability. This is not an abstract idea or related to music, a literary work, a compilation or a mere arrangement of data.

As a result of the above, the above-cited claim limitation is not non-functional descriptive material as asserted by the Examiner. The Examiner must not ignore this claim limitation.

Applicants further assert that Kinra does not teach "wherein the supplier metrics are selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement"

as recited in claim 11 and similarly in claim 19. The Examiner admits that Kinra does not teach the above-cited claim limitation. However, the Examiner asserts that these categories are nonfunctional material and therefore can be ignored in light of *In re Gulack* and *In re Lowry*. Office Action (5/29/2009), page 10. Applicants respectfully traverse.

The cases that the Examiner cites are found in M.P.E.P. §2106.01. According to M.P.E.P. §2106.01, *In re Gulack* and *In re Lowry* are directed to the situation in which the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine. M.P.E.P. §2106.01. That is not the case here. As pointed out, there are numerous limitations in the claimed inventions not taught or suggested in Kinra. Consequently, the Examiner's reliance of *In re Gulack* and *In re Lowry* is improper.

Further, M.P.E.P. §2106.01 defines "non-functional descriptive material" as including but not limited to music, literary works, and a compilation or mere arrangement of data. M.P.E.P. §2106.01 continues by stating that when non-functional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. M.P.E.P. §2106.01 further states that merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, does not make it statutory. Further, M.P.E.P. §2106.01 states that non-statutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

The above-recited limitation that the Examiner claims to be non-functional descriptive material is not related to music, literary works, a compilation or mere arrangement of data. Neither is this claim limitation an abstract idea. Neither is this claim limitation protectable under copyright law. This limitation is not non-functional descriptive material.

The above-cited claim limitation is directed to further defining the supplier metrics. These are defined to be selected from the set consisting of market

penetration, priority as determined by a customer, revenue potential, and state of technology advancement. This is not an abstract idea or related to music, a literary work, a compilation or a mere arrangement of data.

As a result of the above, the above-cited claim limitation is not non-functional descriptive material as asserted by the Examiner. The Examiner must not ignore this claim limitation.

Applicants further assert that Kinra does not teach "wherein the step of determining includes a step of averaging non-zero partial scores" as recited in claim 12 and similarly in claim 20. The Examiner cites column 4, lines 40-68 of Kinra as teaching the above-cited claim limitation. Office Action (12/10/2008), page 6; Office Action (5/29/2009), page 10. Applicants respectfully traverse.

Kinra teaches that the criterion score is normalized in the sense that the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion. Column 4, lines 43-46. Kinra further teaches an example in which two product data elements may be grouped into the automated testing criterion, whereas seven product data elements may be grouped into the process modeling criterion. Column 4, lines 46-49. Kinra further teaches that the two product data elements for the automated testing criterion may have numerical values of "3" and "5", and corresponding criterion weighting values 24 of "5" and "5," respectively. Column 4, lines 49-53. Additionally, Kinra teaches that the raw criterion score for the automated testing criterion is "40" (i.e.,  $(3 \times 5) + (5 \times 5) = 40$ ). Column 4, lines 53-54. Further, Kinra teaches that the seven product data elements for the process modeling criterion may have numerical values (1, 3, 3, 0, 5, 1, 3) and corresponding criterion weighting values 24 (5, 1, 1, 3, 5, 3, 3). Column 4, lines 55-58. Furthermore, Kinra teaches that the raw criterion score for the process modeling criterion is "48" (i.e.,  $(1 \times 5) + (3 \times 1) + (3 \times 1) + (0 \times 3) + (5 \times 5) + (1 \times 3) + (3 \times 3) = 48$ ). Column 4, lines 58-60. In addition, Kinra teaches that when the raw criterion score of "40" for the automated testing criterion is divided by the sum of the associated criterion weighting values 24 of "10" (i.e., 5 and 5), a normalized score of "4" is generated for this criterion;

however, when the raw criterion score of "48" for the process modeling criterion is divided by the sum of its associated criterion weighting values 24 of "21" (i.e., 5, 1, 1, 3, 5, 3, and 3), a normalized score of "2.286" is generated. Column 4, lines 60-67.

Hence, Kinra teaches normalizing a score by dividing the raw score by the sum of the associated criterion weighting values. Normalizing is not the same as averaging the non-zero partial scores. Neither does Kinra teach that the raw score is obtained by taking the average of the non-zero scores. Instead, the raw score is obtained by multiplying the numerical value by its associated weight for each product data element and then summing the weighted numerical values.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 12 and 20, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

In response to Applicants' above arguments, the Examiner asserts that normalizing is a type of average. Office Action (5/29/2009), pages 3 and 10. Applicants respectfully traverse.

Kinra teaches a criteria scorer 26 that generates these criterion scores by weighting each numerical value in a product data file 16 or an environment data file 22 with a criterion weighting value 24 retrieved from criterion weighting value 24. Column 4, lines 33-36. Kinra further teaches that each criterion weighting value 24 reflects the relative importance to the criterion of the functional capacity or feature specified in an evaluation statement. Column 4, lines 36-39. Additionally, Kinra teaches that the weighted numerical values are summed together to produce a raw criterion score. Column 4, lines 39-39-40. Furthermore, Kinra teaches that this raw criterion score is divided by the sum of the associated criterion weighting values 24 to produce a normalized criterion score. Column 4, lines 40-43. Further, Kinra teaches that the criterion score is normalized in the sense that the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion. Column 4, lines 43-46.

Hence, Kinra teaches that a normalized score is provided by dividing the raw criterion score by the sum of the associated criterion weighting values. Kinra further

teaches that the criterion score is normalized in the sense that the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion.

Hence, normalizing, as used in Kinra, is not a weighted mean as asserted by the Examiner. Normalizing involves a transformation. See <http://www.merriam-webster.com/dictionary/normalize>. Normalizing means to reduce to a norm or standard. *Id.* Average may refer to an estimation of or approximation to an arithmetic mean. See <http://www.merriam-webster.com/dictionary/average>. Average may represent a middle point. *Id.* Normalizing does not represent a middle point.

Further, the Examiner cites to the definition of weighted mean on statistics.com. Office Action (5/29/2009), page 10. Applicants could not identify any language in the discussion of a weighted mean on statistics.com that would imply that normalizing is the same as averaging. In statistics, normalization is the process of removing statistical error in repeated measured data. See [http://en.wikipedia.org/wiki/Normalization\\_\(statistics\)](http://en.wikipedia.org/wiki/Normalization_(statistics)).

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 12 and 20, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

B. Claims 13-16 and 21-24 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Kinra and in further view of Wolfram.

Applicants respectfully assert that Kinra and Wolfram, taken singly or in combination, do not teach "multiplying the matrix A by an M by N matrix of numerical weights W, to form the M by M matrix  $P=WA$ , to provide partial scores" as recited in claim 13 and similarly in claim 21. The Examiner cites elements 114a-114c and 126a-126d of Kinra as teaching the claimed customer interest categories and further cites elements 112 and 124 of Kinra as teaching the claimed supplier metrics. Office Action (12/10/2008), page 4; Office Action (5/29/2009), page 8. Additionally, the Examiner cites elements 118 and 130 as teaching the claimed numerical values. *Id.* Further, the Examiner cites column 4, lines 33-68 of Kinra as teaching the above-cited claim limitation without the aspect of multiplying the matrix A by an M by N

matrix of numerical weights W. Office Action (12/10/2008), page 4; Office Action (5/29/2009), page 11. Applicants respectfully traverse.

As stated above, in connection with claims 9 and 13, Kinra teaches that criterion evaluation table 122 corresponds to the prototyping and simulation criterion 114c in category evaluation table 111. Column 8, lines 39-41. Kinra further teaches that a product data column 124 of criterion evaluation table 122 includes a list of product data within the prototyping and simulation criterion, where this product data comprises a plurality of evaluation statements 126a-126d. Column 8, lines 41-44. Further, Kinra teaches that a weighting column 128 of criterion evaluation table 122 contains the criterion weighting values 24 for each product data specified in product data column 124. Column 8, lines 44-47. Additionally, Kinra teaches that a PRODUCT 1 value column 130 and a PRODUCT 2 value column 132 contain the numerical values for PRODUCT 1 and PRODUCT 2, respectively, corresponding to the evaluation statements listed in product data column 124. Column 8, lines 47-51. Additionally, Kinra teaches that a normalized criterion score in the prototyping and simulation criterion is provided at the end of each of the PRODUCT 1 and PRODUCT 2 value columns. Column 8, lines 51-54.

Hence, Kinra teaches generating normalized criterion scores for the prototyping and simulation criterion (Examiner asserts that the prototyping and simulation criterion 124 corresponds to the claimed supplier metrics) for products 1 and 2 as illustrated in table 122 of Figure 2. Similarly, Kinra teaches generating normalized criterion scores for the prototyping and simulation criterion for products 1 and 2 as illustrated in table 122 of Figure 2.

Kinra further teaches the process in generating normalized scores, which involves dividing the raw criterion score by the sum of the associated criterion weighting values. Column 4, lines 33-67.

As stated above, in connection with claims 9 and 13, there is no language in Kinra that teaches computing partial scores for the customer interest categories by weighting and summing the numerical values. Instead, Kinra teaches computing normalized scores for the prototyping and simulation criterion which the Examiner

asserts teaches the claimed supplier metrics and not the claimed customer interest categories. There is no weighting and summing being performed to obtain the scores associated with elements 126a-126d which the Examiner alleges teaches the claimed customer interest categories. Hence, Kinra and Wolfram, taken in combination, do not teach forming the M by M matrix  $P=WA$ , to provide partial scores.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 13 and 21, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Claims 14-16 and 22-24 each recite combinations of features of independent claims 13 and 21, respectively, and hence claims 14-16 and 22-24 are patentable over Kinra in view of Wolfram for at least the above-stated reasons that claims 13 and 21, respectively, are patentable over Kinra in view of Wolfram.

Claims 14-16 and 22-24 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Kinra in view of Wolfram.

For example, Kinra and Wolfram, taken singly or in combination, do not teach "wherein the customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability" as recited in claim 14 and similarly in claim 22. The Examiner cites column 4, lines 1-4 and element 112 of Figure 2 of Kinra as teaching the aspects of usability, interoperability and capability. Office Action (12/10/2008), page 8; Office Action (5/29/2009), page 13. Applicants respectfully traverse.

As stated above, Kinra teaches that exemplary criteria include ease of use, application interoperability, automated testing, application partitioning, process modeling, prototyping and simulation, and multilingual support. Column 4, lines 1-4.

The Examiner had previously asserted that elements 112 and 124 correspond to the claimed supplier metrics. Office Action (12/10/2008), page 4. The exemplary criteria cited by the Examiner in column 4, lines 1-4 of Kinra refers to element 124.

Hence, using the Examiner's interpretation of "supplier metrics," the Examiner has not shown that Kinra teaches that customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 14 and 22, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Further, the Examiner asserts that the categories of performance, reliability, maintainability, documentation, and serviceability are old and well known. Office Action (12/10/2008), page 8. While these categories may be known, Applicants respectfully traverse the implied assertion that having the customer interest categories selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, where supplier metrics are evaluated for these customer interest categories is well known in the art. Applicants kindly request the Examiner to provide a reference that teaches having the customer interest categories selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, where supplier metrics are evaluated for these customer interest categories pursuant to M.P.E.P. §2144.03.

Additionally, the Examiner asserts that the categories of performance, reliability, maintainability, documentation, and serviceability are nonfunctional material and therefore can be ignored in light of *In re Gulack* and *In re Lowry*. Office Action (5/29/2009), page 14. Applicants respectfully traverse.

The cases that the Examiner cites are found in M.P.E.P. §2106.01. According to M.P.E.P. §2106.01, *In re Gulack* and *In re Lowry* are directed to the situation in which the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine. M.P.E.P. §2106.01. That is not the case here. As pointed out, there are numerous limitations in the claimed inventions not taught or suggested in Kinra. Consequently, the Examiner's reliance of *In re Gulack* and *In re Lowry* is improper.

Further, M.P.E.P. §2106.01 defines "non-functional descriptive material" as including but not limited to music, literary works, and a compilation or mere arrangement of data. M.P.E.P. §2106.01 continues by stating that when non-functional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. M.P.E.P. §2106.01 further states that merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, does not make it statutory. Further, M.P.E.P. §2106.01 states that non-statutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

The above-recited limitation that the Examiner claims to be non-functional descriptive material is not related to music, literary works, a compilation or mere arrangement of data. Neither is this claim limitation an abstract idea. Neither is this claim limitation protectable under copyright law. This limitation is not non-functional descriptive material.

The above-cited claim limitation is directed to further defining the customer interest categories. These are defined to be selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability. This is not an abstract idea or related to music, a literary work, a compilation or a mere arrangement of data.

As a result of the above, the above-cited claim limitation is not non-functional descriptive material as asserted by the Examiner. The Examiner must not ignore this claim limitation.

Applicants further assert that Kinra and Wolfram, taken singly or in combination, do not teach "wherein the supplier metrics are selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement" as recited in claim 15 and similarly in claim 23. The Examiner admits that Kinra does not teach the above-cited claim limitation. However, the Examiner asserts that these categories are nonfunctional

material and therefore can be ignored in light of *In re Gulack* and *In re Lowry*. Office Action (5/29/2009), page 14. Applicants respectfully traverse.

The cases that the Examiner cites are found in M.P.E.P. §2106.01. According to M.P.E.P. §2106.01, *In re Gulack* and *In re Lowry* are directed to the situation in which the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine. M.P.E.P. §2106.01. That is not the case here. As pointed out, there are numerous limitations in the claimed inventions not taught or suggested in *Kinra*. Consequently, the Examiner's reliance of *In re Gulack* and *In re Lowry* is improper.

Further, M.P.E.P. §2106.01 defines "non-functional descriptive material" as including but not limited to music, literary works, and a compilation or mere arrangement of data. M.P.E.P. §2106.01 continues by stating that when non-functional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. M.P.E.P. §2106.01 further states that merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, does not make it statutory. Further, M.P.E.P. §2106.01 states that non-statutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

The above-recited limitation that the Examiner claims to be non-functional descriptive material is not related to music, literary works, a compilation or mere arrangement of data. Neither is this claim limitation an abstract idea. Neither is this claim limitation protectable under copyright law. This limitation is not non-functional descriptive material.

The above-cited claim limitation is directed to further defining the supplier metrics. These are defined to be selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement. This is not an abstract idea or related to music, a literary work, a compilation or a mere arrangement of data.

As a result of the above, the above-cited claim limitation is not non-functional descriptive material as asserted by the Examiner. The Examiner must not ignore this claim limitation.

Applicants further assert that Kinra and Wolfram, taken singly or in combination, do not teach "wherein the step of determining includes a step of averaging non-zero diagonal elements of P" as recited in claim 16 and similarly in claim 24. The Examiner cites column 4, lines 40-68 of Kinra as teaching the above-cited claim limitation. Office Action (12/10/2008), page 9; Office Action (5/29/2009), page 15. Applicants respectfully traverse.

As stated above, Kinra teaches that the criterion score is normalized in the sense that the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion. Column 4, lines 43-46. Kinra further teaches an example in which two product data elements may be grouped into the automated testing criterion, whereas seven product data elements may be grouped into the process modeling criterion. Column 4, lines 46-49. Kinra further teaches that the two product data elements for the automated testing criterion may have numerical values of "3" and "5", and corresponding criterion weighting values 24 of "5" and "5," respectively. Column 4, lines 49-53. Additionally, Kinra teaches that the raw criterion score for the automated testing criterion is "40" (i.e.,  $(3 \times 5) + (5 \times 5) = 40$ ). Column 4, lines 53-54. Further, Kinra teaches that the seven product data elements for the process modeling criterion may have numerical values (1, 3, 3, 0, 5, 1, 3) and corresponding criterion weighting values 24 (5, 1, 1, 3, 5, 3, 3). Column 4, lines 55-58. Furthermore, Kinra teaches that the raw criterion score for the process modeling criterion is "48" (i.e.,  $(1 \times 5) + (3 \times 1) + (3 \times 1) + (0 \times 3) + (5 \times 5) + (1 \times 3) + (3 \times 3) = 48$ ). Column 4, lines 58-60. In addition, Kinra teaches that when the raw criterion score of "40" for the automated testing criterion is divided by the sum of the associated criterion weighting values 24 of "10" (i.e., 5 and 5), a normalized score of "4" is generated for this criterion; however, when the raw criterion score of "48" for the process modeling criterion is divided by the sum of its associated criterion weighting values 24 of "21" (i.e., 5, 1, 1, 3, 5, 3, and 3), a normalized score of "2.286" is generated. Column 4, lines 60-67.

Hence, Kinra teaches normalizing a score by dividing the raw score by the sum of the associated criterion weighting values. Normalizing is not the same as averaging the non-zero diagonal elements of P. Neither does Kinra teach that the raw score is obtained by taking the average of the non-zero scores. Instead, the raw score is obtained by multiplying the numerical value by its associated weight for each product data element and then summing the weighted numerical values.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 16 and 24, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

In response to Applicants' above arguments, the Examiner asserts that normalizing is a type of average. Office Action (5/29/2009), pages 3 and 15. Applicants respectfully traverse.

Kinra teaches a criteria scorer 26 that generates these criterion scores by weighting each numerical value in a product data file 16 or an environment data file 22 with a criterion weighting value 24 retrieved from criterion weighting value 24. Column 4, lines 33-36. Kinra further teaches that each criterion weighting value 24 reflects the relative importance to the criterion of the functional capacity or feature specified in an evaluation statement. Column 4, lines 36-39. Additionally, Kinra teaches that the weighted numerical values are summed together to produce a raw criterion score. Column 4, lines 39-40. Furthermore, Kinra teaches that this raw criterion score is divided by the sum of the associated criterion weighting values 24 to produce a normalized criterion score. Column 4, lines 40-43. Further, Kinra teaches that the criterion score is normalized in the sense that the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion. Column 4, lines 43-46.

Hence, Kinra teaches that a normalized score is provided by dividing the raw criterion score by the sum of the associated criterion weighting values. Kinra further teaches that the criterion score is normalized in the sense that the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion.

Hence, normalizing, as used in Kinra, is not a weighted mean as asserted by the Examiner. Normalizing involves a transformation. See <http://www.merriam-webster.com/dictionary/normalize>. Normalizing means to reduce to a norm or standard. *Id.* Average may refer to an estimation of or approximation to an arithmetic mean. See <http://www.merriam-webster.com/dictionary/average>. Average may represent a middle point. *Id.* Normalizing does not represent a middle point.

The Examiner cites to the definition of weighted mean on statistics.com. Office Action (5/29/2009), page 15. Applicants could not identify any language in the discussion of a weighted mean on statistics.com that would imply that normalizing is the same as averaging. In statistics, normalization is the process of removing statistical error in repeated measured data. See [http://en.wikipedia.org/wiki/Normalization\\_\(statistics\)](http://en.wikipedia.org/wiki/Normalization_(statistics)).

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 16 and 24, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

IV. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 9-24 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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